109769.0020
Examiner Namitha Pillai
Art Unit2173

REMARKS

This is in response to the first Office Action in the re-opened prosecution of this application following reversal by the Board of Patent Appeal of the final rejection of the claims. Favorable reconsideration of the patentability of the claims of this application is respectfully requested.

In the first Office Action of the re-opened prosecution, all of the claims have been rejected under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 6,704,120 (Leone III et al.). The Leone patent describes printable product templates that include images. An application 60 is the controlling software program running on a computer that generates a personalized printed product 10. The image can be modified by an image processing program 80 that can be on a remote host computer and accessed by application 60, or on the same computer with application 60.

The present invention, as defined by the claims, is very different from Leone. It is an on-line system for creating and printing products such as greeting cards, wherein a "plug-in program" or "first program" is downloaded from a remote site to an Internet web browser on a personal computer which launches the program. The program includes an engine and assembly component for selection and editing of assets of the printed product including design elements and asset information for display, editing and printing assembly, including scaling and resizing, for printing. This is not the same as a program which accesses a separate image processing program, remotely or locally, in order to modify an image component of a card. Because the disclosure of Leone is not identical to the subject matter defined by the pending claims, there is no anticipation under 35 U.S.C. 102(a).

The Leone patent discloses a data template for a personalized printed product incorporating image processing operations. Col. 8, lines 61-63. Specifically, Leone is concerned with image processing in the form of imaging utilities which can be accessed and used to modify a scanned image so that a modified image can be included in the data template for a greeting card to be printed. See Leone, col. 1, FIELD OF THE INVENTION; col. 2, lines 8-15; col. 3, lines 13-16: "automating the utilities that provide these image modifications would allow their use by an unskilled operator in preparing a greeting card, invitation, or similar type of personalized printed product."; col. 4, lines 8-12: "...providing a flexible set of imaging utilities for automated

enhancement of personalized printed product, where the set of imaging utilities can be regularly updated and available to customers in preparing printed products."; col. 4, lines 38-42: "a new personalized printed product to be introduced that uses an image processing operation that is not available with the original software application itself."

The described system includes an application 60 which is the controlling software program that runs on a personal computer to generate a personalized printed product (i.e. greeting card), and which associates each product or card design with a product template from a product template database. Leone, col. 6, lines 6-14. The application 60 has the ability to extend or augment itself based on the needs of specific products, and specifically for product templates which include an image processing operation for a scanned image. Application 60 does this by accessing an image processing program 80 to be under the control of application 60. Leone, col. 6, lines 32-40. This type of program augmentation, which occurs during the execution of a main program, is referred to as "reflection" by those skilled in the Java programming language. Leone describes the use of XML or Java for page definition languages and standard to define a product template for data presentation. See Leone, col. 1, lines 38-65 and col. 8, lines 35-54. Using XML as the preferred embodiment of the product data, Leone describes three different methods for the inclusion of code related to the special image processing. This is not the same as or equivalent to the claimed program of the present invention.

XML evolved out of SGML, becoming a W3C recommendation as a standard in February 1998 (http://en.wikipedia.org/wiki/XML). The primary purpose of XML is to facilitate the sharing of data across different systems, particularly systems connected via the Internet. Like all markup languages, it uses a series of tags (generally found in pairs, such as <Page> and </Page>) and values (for example <Location x=1 y=2>). Sharing is achieved by publishing the specific tags and values used to describe a specific set of data.

Leone describes as an alternative embodiment,

> "A downloaded Java class that serves as image processing program 80 could optionally be embodied as an applet. This would allow application 60 to operate within a Web browser, offering the advantage of widespread access to imaging and printing capabilities for internet users."

Col. 8, lines 49-54. But downloading of an image processing program is not the same as the claimed "first program" and "plug-in program" which include modification functions for modifying the defining data and assembly functions for assembling a printed product for printing. Those functions are performed by Leone's application 60 which as described runs on the client computer. See Leone, FIG. 2 and col. 6, lines 6-8.

A Java applet is computer code written in the Java programming language. Java applets can run in a web browser using a Java virtual machine (JVM), or in Sun's AppletViewer, a stand alone tool to test applets. Applets are used to provide interactive features to web applications that cannot be provided by HTML. They are executed in a *sandbox* by most web browsers, preventing them from accessing local data. The code of the applet is downloaded from a web server and the browser either embeds the applet into a web page or opens a new window showing the applet's user interface." (http://en.wikipedia.org/wiki/Java_applet).

The portion of the Leone patent which describes the applet embodiment is technically incorrect because the interrelationship between the application 60 and the image processing program 80 is reversed. If application 60 were to be written as an applet to operate within a Web browser, then the image processing program 80 could be also embodied as an applet. As described, application 60 is clearly the controlling client-resident program, so that the implementation options of the image processing program 80 are dependent upon application 60. In Leone, col. 8, lines 49-54, this description is reversed.

In addition to this fundamental error, the teaching is incomplete and therefore non-enabling, even for one skilled in the art (of Java programming). Those skilled in the art would know that the Java application 60 could be invoked equally as well from a browser as from a command line. As an example, if application 60 resided on a web server, a sample command to start it might be: "http://webserver.com/program60.jar". In this case, the web browser serves no function other than a means to invoke application 60, and application 60 would run with no interaction with the browser (i.e., it would not be executed in the *sandbox*). Leone does not provide this description. Further, Leone does not teach how program 80, if developed as an applet, can be invoked and communicate with application 60 when application 60 is not an applet. Also, because applets execute in the sandbox, they are prohibited from access (read or write) to the client's local disk. It is apparent to one skilled in the art that if application 60 and

program 80 are applets, then the preferred embodiment (described column 6, lines 22-24) with the templates database being stored locally is not an option. The privacy restrictions of the sandbox restrict this. Leone does not teach that the network or remote host options must be used.

The present claims are patentably distinct over Leone on this point by the language:

> "a client computer for accessing said server, wherein said at least one server downloads said first program and said defining data to said client computer; ...".

Leone does not teach or suggest that the application 60 can be downloaded, and in fact consistently teaches the opposite. Leone, col. 4, lines 30-34, 38-44, 47-52; col. 6, lines 6-8, 40-43; "It should be noted that image processing program 80 need not be on a separate host computer, but could alternately be locally stored on the same computer that hosts application 60.". This teaches away from the invention as claimed wherein the "first program" or "plug-in program" are stored on and downloaded from a server, and which retrieve the product-defining data – enable modification of the data – and assemble the product for printing, is downloaded from a server. See Applicant's claims 1, 14, 22 and 27.

Further, the "first" or "plug-in" programs as claimed differ from an applet in several respects, including:

1. access via a web browser provides a way for the programs to register themselves and remain permanent on the client computer;
2. the programs do not have the same security restrictions of an applet and have access to a local disk; providing a greater range of flexibility on where input files are located; in addition, the programs have write capability, and are able to update definition files such that user-specified manipulations are recorded for future use.

By disclosing only the downloading of an applet as an image processing program, Leone does not teach or suggest the claimed use of a plug-in program with these features, functions and benefits. Furthermore, the Leone alternative embodiment, wherein application 60 and program 80 are applets, requires a download each time that the browser invokes the programs. For larger programs, this is an inconvenience and is inconsistent with some of the objectives of the invention. Applicants' invention as claimed has the advantage of being resident on the client

computer between sessions, thus eliminating the need to reload the on-line printable product creation system every time it is needed. The invention as claimed is not restricted from using a local disk for definition files, while retaining the advantages of reach (penetration into the user community) for browser-based applications.

Claim 10 was rejected under 35 U.S.C. 112, second paragraph, for the reference to "a printable product". Although the rejection as stated in paragraph 1 of the Office Action is not clear, and also refers to claim 11 (which does not make reference to "a printable product"), claim 10 has been amended to refer to "the printable product" consistent with the language of the claim preamble language: "modifying and printing a printable product". The term "printable product" is well-defined in the specification. Withdrawal of this rejection is therefore respectfully requested.

Claims 1-5 and 8-26 have been rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,704,120 B1 (Leone III et al.), herein "Leone" or "the Leone patent". This rejection includes independent claims 1, 14, 22 and 23, which define, among other things, "a first program" (claims 1 and 14) and "a plug-in program" (claims 22 and 23) to provide a client/user with access to "defining data" and the ability to modify the defining data for a printable product. As explained below, the Leone patent does not disclose or suggest this program approach to enabling users to modify aspects of a printable product. The only downloading of code over a network which Leone describes is a Java Applet, which as further explained herein is not the same as or equivalent to the claimed "first program" or "plug-in program".

With respect to claim 1, the examiner states, "Leone discloses a first program providing a user with modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing (column 4, lines 41-51)." The cited excerpt from Leone describes an image processing operation that is not available with the original software application, which can be made available over a network to a remote host that supplies executable program code for implementing the operation. The image processing operation can be defined, accessed and used independent from a software application that controls how a personalized printed product is created. Thus, Leone does not disclose "a first program providing a user with modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing;", as defined by claim 1.

The "new image processing operation" is program 80, which is distinct from the application 60 that contains the assembly functions. As described, the remote program 80 does not have any printing assembly capability.

Leone Figure 2 and column 6 lines 37-40 are cited "wherein the server downloads the first program and the defining data to the client computers." The cited text references both program 80 and application 60. Interpreting "first program" of claim 1 to be program 80 conflicts with the clear language of claim 1 that the first program provides a user with a modification function for modifying the defining data and assembly functions for assembling a printable product. Figure 2 does not show use of a network for application 60, if it is the "first program".

With respect to the claim 10 limitation of: "modifying a browser program on a personal computer of a user to allow the user to edit the defining data within the browser program", Leone does not teach, at col. 8, lines 49-53, to modify a browser program. Downloading the image processing program 80 as an applet does not modify application 60. Column 4, lines 22-28 of Leone merely describe prior art systems which modify data and format the data for printing. See Cannon, U.S. Patent No. 5,056,029.

With respect to claim 14, the Examiner contends that Leone discloses, at col. 8, lines 49-53, an online system accessible via computer network. But as previously noted the cited excerpt describes only the downloading of the image processing program 80, not the "first program" with all of its functionality as defined by claim 14.

With respect to claims 22 and 23, as noted above Leone does not disclose the claimed "plug-in program" which is stored on a web server and downloaded to a web browser. The cited excerpt of column 8, lines 16-60, does not describe the application 60-- which prepares the template 56 and document type definitions 70 to determine the layout of the printed product 10-- as being downloaded from a server.

Regarding the dependent claims 2-9, 11-13, 15-21 and 24-26 which further define the claimed system including the functions of the downloaded program, Leone does not anticipate any of the defined features of these claims because all of the product formation and processing is done by the resident application 60 which is not downloaded from a server to a client computer.

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Withdrawal of each of the rejections of the claims for the foregoing reasons is therefore respectfully requested. If the Examiner believes there are any further matters, which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned. If there are any fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-0959, referencing our Docket No. 109769.0020.

Respectfully submitted,
ROETZEL & ANDRESS

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